

REMARKS

The Examiner is thanked for the interviews of September 14 and 16. In the first interview, the independent claims and the cited art (Dodson) were discussed. Primarily, that Dodson, a foot-operated platform was not a hand operated mouse and that Dodson failed to disclose a housing that encases internal components. The undersigned presented the Examiner with a mouse that embodied the claims, and a demonstration was performed. In the second interview, proposed amendments were discussed. Primarily, adding additional structure to help further define the term "encase". Although no formal agreement was reached, it appeared from the various discussions that the claims overcame the Dodson reference.

In the Office Action, the Examiner rejected claims 20-22, 25-28, 30-34, 36, 37, 39 and 42-45 under 35 USC 102 and claims 46 and 47 under 35 USC 103. The rejections are fully traversed below.

Claims 20, 25, 32, 36 and 42 have been amended. Thus, claims 20-22, 25-28, 30-34, 36, 37, 39 and 42-47 are pending in the application. Reconsideration of the application is respectfully requested.

ISSUES UNDER 35 USC 102(b)

Claims 20-22, 25-28, 30-34, 36, 37, 39 and 42-45 have been rejected under 35 U.S.C. §102(b) as being unpatentable over *Dodson et al.* U.S. Patent No. 5,841,426.

While *Dodson* may disclose a platform 18 that pivots relative to a base 12 via a ball and socket joint 22/24, *Dodson* fails to teach or suggest a platform and a base that encases the internal components of the controller 10. As shown in Figs. 1 and 2, the internal components are exposed through gaps formed between the pedestal 18 and the base 12. The pedestal 18 and base 12 are platforms that are connected via a ball and socket joint. Neither includes walls for enclosing or encasing internal components. The combination of the pedestal 18 and the base 12 simply does not form a housing, and therefore the rejections are unsupported by the art and should be withdrawn.

Furthermore, while *Dodson* may disclose a mouse, *Dodson* does not teach or suggest a hand held mouse. In *Dodson*, the mouse is a foot-operated device. And a foot-operated device is simply not configured to be manipulated by a hand. For one, the foot-operated device is much larger than a hand operated device thereby making hand manipulation difficult. For another, the platform is a flat pedestal that is not easily grasped by the hand. It appears that the platform operates like an acceleration pedal in a car. Furthermore, the motor control of the foot is much coarser the motor control of the hand and therefore a certain amount of slack is built into the foot-operated device. As stated by *Dodson*, "It should be noted that careless or involuntary horizontal motions of the foot will not inadvertently contact a button type switch (Col. 2, lines 30-32)." Any amount of slack would make maneuvering the handheld mouse difficult. Furthermore, it is not a very elegant solution and therefore would leave a negative impression on the user. For at least these reasons, it would be difficult to imagine operating the foot operated device with a hand, especially in the manner that mice are typically used, i.e., it would not be very ergonomic thereby leading to hand fatigue. It should be noted that one advantage of the present invention is that it allows all users (large, small and deformed hands) to comfortably select data or execute commands by a simple and light wrist action. See for example the Abstract.

Moreover, it should be pointed out that *Dodson* teaches away from a hand-held mouse when he states, "Computers employ for such tasks as word processing typically have both keyboards and control devices requiring manual grasping and manipulation. This arrangement leads to the frequent requirement that one hand be removed from the keypad to operate the manual control device or mouse. This style of operation is somewhat inefficient since the hand operating the mouse must be replaced on the keypad prior to resuming full operation of the keypad. The prior art addresses this problem by suggesting foot-operated controls which could replace the mouse. The user's hands are thus freed to operate the keypad, while traditional mouse functions are performed by the foot. (Col. 1, lines 15-30)," and "The present invention provides a mouse type of control for computers which is adapted to operate by foot (Col. 2, lines 1-3)." For this reason alone, the rejection is improper and should be withdrawn.

Claim 20 (and dependents)

In contrast to *Dodson*, claim 20 (and its dependents) specifically requires, "...an integral top member cooperating with the base member to form a housing of the input device, the base

member and integral top member working together to encase internal components of the input device..." Accordingly, the rejection is unsupported by the art and should be withdrawn.

Also in contrast to *Dodson*, claim 20 (and its dependents) specifically requires, "...the base member forming the bottom surface of the housing, the integral top member forming the top and side surfaces of the housing..." *Dodson* teaches a platform, and the platform does not include sides. Accordingly, the rejection is unsupported by the art and should be withdrawn.

Claim 32 (and dependents)

In contrast to *Dodson*, claim 32 (and its dependents) specifically requires, "...a top member mechanically coupled with the base member to form the mouse housing and to encase said mouse electronics..." Accordingly, the rejection is unsupported by the art and should be withdrawn.

Also in contrast to *Dodson*, claim 32 (and its dependents) specifically requires, "...an electronic switch fully contained inside the mouse housing such that the electronic switch is protected and hidden from view ..." As shown in Fig. 1, the switches 32 and 38 are exposed through gaps formed between the pedestal 18 and the base 12. Accordingly, the rejection is unsupported by the art and should be withdrawn.

Also in contrast to *Dodson*, claim 32 (and its dependents) specifically requires, "A handheld computer mouse...the mouse housing being configured to be grasped and manipulated by a hand of a user..." Accordingly, the rejection is unsupported by the art and should be withdrawn.

Claim 36 (and dependents)

In contrast to *Dodson*, claim 36 (and its dependents) specifically requires, "...a top member cooperating with the base member to form a housing of the handheld computer mouse that substantially encloses internal components of the handheld computer mouse ..." Accordingly, the rejection is unsupported by the art and should be withdrawn.

Also in contrast to *Dodson*, claim 36 (and its dependents) specifically requires, "...the top member forming the top and side surfaces of the housing and being configured for placement inside a user's hand, the base member forming the bottom surface of the housing and being configured for contact with a support surface..." Accordingly, the rejection is unsupported by the art and should be withdrawn.

Also in contrast to *Dodson*, claim 36 (and its dependents) specifically requires, "A handheld computer mouse...the top member ...being configured for placement inside a user's hand..." Accordingly, the rejection is unsupported by the art and should be withdrawn.

Claim 42 (and dependents)

Also in contrast to *Dodson*, claim 42 (and its dependents) specifically requires, "...an integral top member mechanically coupled to the base member, the integral top member cooperating with the base member to fully encase the electronics disposed therein..." Accordingly, the rejection is unsupported by the art and should be withdrawn.

Also in contrast to *Dodson*, claim 42 (and its dependents) specifically requires, "...the integral top member forming the top and side surfaces of the mouse housing, the base member forming the bottom surface of the mouse housing..." Accordingly, the rejection is unsupported by the art and should be withdrawn.

Dependent Claims

Although the rejections to the dependent claims 21, 22, 25-28, 30, 31, 33, 34, 37, 39 and 43-47 should be withdrawn for at least the reasons as above, it should be noted that they offer additional language that is unsupported by the art. For example: In contrast to *Dodson*, claim 26 specifically requires, "...a biasing spring pad for biasing the integral top member in the first position." In contrast to *Dodson*, claim 28 specifically requires, "...the integral top member includes a pair of pivots and wherein the base member includes a pair of snap mechanisms that mate with the pair of pivots." No such feature is described in *Dodson*. The most that can be said is that *Dodson* teaches a ball and socket joint. This however is not the same. In contrast to *Dodson*, claim 43 specifically requires, "...the pivot and snap mechanisms are in an opposed relationship in the back of the input device, the pivot and snap mechanisms providing an axis

around which the integral top member rotates during the clicking action." In contrast to *Dodson*, claim 44 specifically requires, "...the integral top member is configured for placement inside a user's hand, at least a back portion of the integral top member having an external contour that substantially conforms to the contour of the palm-side surface of the hand." In contrast to *Dodson*, claim 45 specifically requires, "...the input device is configured as a handheld mouse, and wherein the base member carries a mechanism for generating cursor control signals when the input device in the form of a handheld mouse is moved about a surface via a user's hand." Accordingly, the rejections are unsupported by the art and should be withdrawn.

SUMMARY

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,

BEYER WEAVER & THOMAS, LLP



Quin C. Hoellwarth
Reg. No. 45, 738

P.O. Box 70250
Oakland, CA 94612-0250
(650) 961-8300